

REMARKS/ARGUMENTS

The final Office Action of January 23, 2006, has been carefully reviewed and this response addresses the Examiner's concerns stated in the Office Action. All objections and rejections are respectfully traversed. Applicants appreciate the explanations provided in the Office Action.

I. STATUS OF THE CLAIMS

Claims 1-20 are pending in the application.

Claims 1-9 and 11-19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Barrick et al., U.S. Patent Number 6,006,260, issued on December 21, 1999 (Barrick).

Claims 10 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The previous rejection of claims 1-10 under 35 U.S.C. § 101 has been overcome.

The previous rejection of claims 1-20 under the judicially-created doctrine of obviousness-type double-patenting has been overcome.

II. ALLOWABLE SUBJECT MATTER

On page 4, the Office Action states that claims 10 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In view of Applicants' belief that all claims are allowable, Applicants have not rewritten the claims at this time, but reserve the right to do at later date.

III. REJECTIONS UNDER 35 U.S.C. § 102(e)

On pages 4-6, the Office Action states that claims 1-20 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Barrick. Applicants respectfully point out that claims 10 and 20 have been objected to, so that the listing of rejected claims should read 1-9 and 11-19.

Applicants respectfully point out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. As provided by the remarks set forth below, clearly this is not the case with the present rejection of the claims. Applicants assert that Barrick cannot anticipate Applicants' claims 1 and 11 (and claims 2-10 and 12-20 which, respectively, depend therefrom) for at least the following reasons:

(1) Applicants' transaction is distinct from Barrick's recorded time and Barrick's protocol invocations such as an HTTP GET request, because web browser activity which forms Applicants' transaction is gathered from a series of web pages and their contents whereas recorded time could be the time between web pages but not the pages and contents themselves, and an HTTP GET request might request web pages but is not the page or the page's contents.

(2) Neither Applicants' claimed test instructions and nor Applicants' claimed transaction is equivalent to Barrick's HTTP GET request.

(3) Barrick's logging a time and Applicants' recording and saving a transaction are different actions requiring different software to accomplish them.

(4) Barrick does not disclose Applicants' claimed test instructions to record web browser activity to generate a transaction because Barrick does not track web browser activity but instead calculates the loading time for each web page.

(5) Barrick does not disclose or suggest Applicants' claimed test instructions to edit the transaction because editing a transaction could include, for example, changing the order of the web pages invoked, or changing the user data provided in the web page, while Barrick states providing timing information in an HTTP GET request.

(6) Barrick does not disclose Applicants' claimed recording browser activity as a series of steps, or recording browser activity at all, because recording browser activity as a series of steps involves recording the web pages that the user requests, the data entered into those web pages, and response to the requests, etc., while Barrick simply sends out specific defined web pages and computes a download interval. In Barrick, no browser activity is recorded whatsoever, in steps or otherwise.

(7) Barrick does not disclose Applicants' claimed editing a transaction, because Barrick is modifying a protocol packet to include data.

(8) There is no concept in Barrick whatsoever concerning required and prohibited strings.

Further arguments with respect to the patentability of claims 1-20 are provided below. In addition, following the arguments listed below, Applicants specifically address the Examiner's latest comments in order to further support the allowance of claims 1-20.

On pages 4 and 6, with respect to claims 1 and 11, with reference to Barrick's passages col. 2, lines 18-35 and col. 4, line 60 – col. 5, line 6, the Office Action states that Barrick discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured to direct a processor to interact with the web browser and the Internet server system to record web browser activity to generate the transaction.

In the first cited passage (col. 2, lines 18-35), Barrick states that the browser agent tracks a loading time for each web page. In the second cited passage (col. 4, line 60 – col. 5, line 6), Barrick states that a relay server transfers the download timing information and information about the user machine where it resides to a database server.

In rebuttal to the above, Barrick does not disclose Applicants' claimed test instructions to record web browser activity to generate a transaction because Barrick does not track web browser activity but instead calculates the loading time for each web page.

On pages 4 and 6, with respect to claims 1 and 11, with reference to Barrick's passages col. 2, lines 18-53 and col. 8, line 27 – col. 9, line 45, the Office Action states that Barrick discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured to direct a processor to interact with the web browser and the Internet server system to record web browser activity to edit the transaction.

In the first cited passage (col. 2, lines 18-53), Barrick states a browser agent that tracks a loading time for each web page and provides a parameter indicative of the loading

time in a modified get request. In the second cited passage (col. 8, line 27 – col. 9, line 45), Barrick states automatic web page download timing.

In rebuttal to the above, Applicants assert that Barrick does not disclose or suggest Applicants' claimed test instructions to edit the transaction because editing a transaction could include, for example, changing the order of the web pages invoked, or changing the user data provided in the web page, while Barrick states providing timing information in an HTTP GET request.

On pages 5 and 6, with respect to claims 1, 6, 11, and 16, with reference to Barrick's passages col. 2, lines 36-53 and col. 7, line 52 – col. 8, line 26, the Office Action states that Barrick discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured to direct a processor to interact with the web browser and the Internet server system to record web browser activity to perform an automated test of the Internet server system using the transaction and display test results to the user from the automated test; and the Office Action states that Barrick further discloses the test instructions are further configured to direct the processor to record the browser activity as a series of steps and to edit the transaction to specify test measurements for each step.

In the first cited passage (col. 2, lines 36-53), Barrick states that the browser agent tracks a loading time for each web page and provides a parameter indicative of the loading time in a modified get request. In the second cited passage (col. 7, line 52 – col. 8, line 26), Barrick states that the user initiates the browser agent through an HTML page, and the browser agent computes the time between when the get request is sent and when the web page associated with the get request is received.

In rebuttal to the above, Barrick does not disclose Applicants' claimed recording browser activity as a series of steps, or recording browser activity at all, because recording browser activity as a series of steps involves recording the web pages that the user requests, the data entered into those web pages, and response to the requests, etc., while Barrick simply sends out specific defined web pages and computes a download interval. In Barrick, no browser activity is recorded whatsoever, in steps or otherwise.

In further rebuttal to the above, Barrick does not disclose editing the transaction to specify test measurements because editing a transaction to include test measurements can include, for example, changing the time between when web pages are presented to the user, or changing the required string in an Internet server system response (Applicants' Specification, page 11, lines 19-20), whereas Barrick modifies an HTTP GET request to insert an elapsed time that for a transfer that has already occurred in order to provide that time to a system that is accumulating statistics. Barrick is not editing a transaction, but rather modifying a protocol packet to include data. Thus, Barrick does not anticipate Applicants' claims 1, 6, 11, and 16.

On pages 4 and 6, with respect to claims 1 and 11, with respect to Barrick's passages col. 2, lines 36-53 and col. 9, lines 28-45, the Office Action states that Barrick discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured to direct a processor to interact with the web browser and the Internet server system to record web browser activity to save the transaction for subsequent automated testing of the Internet server system; and a storage medium configured to store the test instructions.

In the first cited passage (col. 2, lines 36-53) Barrick states that the browser agent tracks a loading time for each web page and provides a parameter indicative of the loading time in a modified get request. In the second cited passage (col. 9, lines 28-45), Barrick states making use of fields in the get message header and by making use of cookies to transfer data.

In rebuttal to the above, Barrick does not disclose Applicants' claimed storage medium configured to store test instructions because although in Barrick, test results can be stored on a central database (Barrick col. 2, line 8), and in Barrick, user information can be stored in a cookie, Barrick does not disclose or suggest storing test instructions (claim 1), Applicants' claimed instructions that direct a processor to interact with a web browser and Internet server system to record web browser activity. Further, neither the saving of test results nor the saving of cookies is accomplished by Applicants' claimed interacting with a web browser and Internet server system to record web browser activity to generate a transaction, and thus neither of Barrick's storage options anticipates

Applicants' claimed saving a transaction (claim 11). Therefore Barrick does not anticipate Applicants' invention as claimed in claims 1 and 11.

On pages 5 and 6, with respect to claims 3, 4, 13, and 14, with respect to Barrick's passages col. 2, lines 18-35 and col. 4, lines 60 – col. 5, line 6, the Office Action states that Barrick discloses the test instructions are further configured to direct the processor to record the web browser activity to generate test measurements, wherein one of the test measurements is a sequence of web pages.

In the first cited passage (col. 2, lines 18-35), Barrick states that the browser agent tracks a loading time for each web page. In the second cited passage (col. 4, lines 60 – col. 5, line 6), Barrick states that the browser agent sends download timing information and user machine information obtained during the registration process to a relay server in the form of a get request that has a predefined format, and that the relay server transfers the data to a database server which can be located in various places.

In rebuttal to the above, Barrick does not disclose Applicants' claimed recording of web browser activity to generate test measurements, which can include a sequence of web pages. In Barrick, single web pages can be used for timing testing, but Barrick has no need to generate a sequence of web pages because the purpose of Barrick is to test the elapsed time to load a web page. Applicants' claimed sequences of web pages that form test measurements are different from Barrick's test page that is used to prompt the system to compute the elapsed time because Applicants claimed that web pages themselves are the test measurements. Thus, Applicants assert that Barrick does not anticipate Applicants' claims 3 and 4.

On pages 5 and 6, with respect to claims 5, 7-9, 15, and 17-19, with reference to Barrick's passage col. 7, lines 9-67, the Office Action states that Barrick discloses the test instructions are further configured to direct the processor (a) to add test measurements to the transaction including transaction time and transaction data transfer rate, and (b) that one of the test measurements for each step is elapsed time, one of the test measurements for each step is a required string in an Internet server system response and one of the test measurements for each step is a prohibited string in an Internet server system response.

In the cited passage (col. 7, lines 9-67), Barrick states that Barrick's browser agent requests a single autonomous web page, perhaps repeatedly, and measures the download interval for that single web page.

In rebuttal to the above, Barrick does not disclose or suggest Applicants' claimed adding test measurements to a transaction including transaction time and transaction data transfer rate because adding test measurements to a transaction includes such actions as specifying (versus measuring) the elapsed time between web pages, and specifying a required string in an Internet server response. Barrick discloses no such concepts because the purpose of Barrick is to gather statistics with respect to web page loading. For these reasons, Barrick does not anticipate Applicants' claim 5.

In further rebuttal, Barrick does not disclose Applicants' claimed elapsed time between steps because Barrick is measuring elapsed time for loading a web page, but not between steps in a transaction. The loading of a web page is only part of time required to complete a step in Applicants' claimed transaction because the transaction includes web browser activity, not simply loading web pages. Further, there is no concept in Barrick whatsoever concerning required and prohibited strings. Barrick states the contents of the browser agent HTML page, but those contents contain simply a pointer to the web page that is actually retrieved. There is no mention of the form or required/prohibited return content of the web page that is retrieved, and thus Barrick cannot anticipate Applicants' claims 7-9.

Since Barrick does not anticipate each and every element of Applicants' independent claims 1 and 11, either expressly or inherently, Applicants' independent claims 1 and 11, as well as dependent claims 2-10 and 12-20 that depend, either directly or indirectly, therefrom and that further define the invention, a rejection under 35 U.S.C. § 102 is inappropriate. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Barrick to meet Applicants' patentable limitations.

Applicants respectfully assert that independent claims 1 and 11, as well as claims 2-10 and 12-20 that depend, either directly or indirectly, therefrom and that further define the invention are now in condition for allowance. Applicants respectfully request the Examiner to withdraw rejections under 35 U.S.C. § 102(e) for the reasons set forth above and find claims 1-20 to be allowable.

IV. RESPONSE FOR ARGUMENTS

On pages 2-4, the Office Action states a response to arguments that are made in Applicants' Office Action response of November 3, 2005. Applicants respectfully disagree with the Office Action at least in the following ways.

(1) The Office Action states that in support of the arguments a majority of the arguments of the Applicants are dependent upon transaction, that Applicants define multiple of the related terminology but do not define transaction, and that therefore Examiner uses broadest possible interpretation.

In rebuttal to the above, Applicants respectfully point out that claim 1 states that the Internet server system is directed by the test instructions to record web browser activity to generate a transaction. Applicants therefore explicitly state that a transaction is generated from web browser activity. Web browser activity is gathered from a series of web pages and their associated data. Applicants' Specification states that session servers track and respond to individual user activity by selecting web pages with appropriate transaction data, that transaction servers support session servers by exchanging transaction data, and that database servers store transaction data (Applicants' Specification, page 6, lines 18-21). Thus, Applicants have defined Applicants' claimed web browser activity in Applicants' Specification, and therefore have defined Applicants' claimed transactions. In *Phillips v AWH Corp.* (Fed Cir 2005) (Appeal No.: 03-1269, -1286, slip op. at 11 (Fed. Cir. July 12, 2005)), the courts emphasized the importance of the specification in claim construction because 35 U.S.C. § 112 requires that the specification describe the claimed invention in full, clear, concise, and exact terms. In *Phillips*, the court held that "[u]ltimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim" (*Phillips* at slip op. 15 (quoting *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998))). Applicants have clearly defined transactions to include recorded web browser activity, which is distinct from Barrick's recorded time, and which is distinct from Barrick's protocol invocations such as an HTTP GET request, because web browser activity is gathered from a series of web pages and their contents whereas recorded time could be the time between web pages but not the

pages and contents themselves, and an HTTP GET request might request web pages but is not the page or the page's contents.

(2) The Office Action states that Applicants' claimed test instruction (Applicants' claim 1) is Barrick's HTTP GET and that Applicants' claimed transaction is Barrick's HTTP GET request. Applicants assert that an HTTP GET and an HTTP GET request are one and the same after reviewing the usage of that terminology in Barrick.

In rebuttal to the above, Applicants define test instructions to include transaction configuration instructions, page transition instructions, proxy instructions, request instructions, and response instructions (Applicants' Specification, page 11, lines 1-3). Thus, Applicants disagree with the Office Action because Applicants' claimed test instructions cannot be equivalent to Applicants' claimed transactions generated from web browser activity. The difference between test instructions and a transaction is analogous to the difference between a compiler and the compiled code because the test instructions formulate the structure of the transaction while the transaction itself executes the desired task. For this reason, Applicants assert that the argument stated by the Office Action that test instructions and the transaction are both HTTP GET requests fails.

(3) The Office Action states that Applicants' claimed recording browser activity (Applicants' claims 1 and 11) is Barrick's browser agent that is operable to a log, and that Applicants' claimed saving a transaction is Barrick's saving is disclosed as a log.

In rebuttal to the above, Barrick states (col. 2, lines 40-41 and 59) that the browser agent logs the time corresponding to when the HTTP GET request was sent. Barrick is logging a time, whereas Applicants are saving a transaction. Logging a time would involve snapping the time at the moment the HTTP GET request was detected and storing the snapped time to memory or mass storage. Applicants' claimed recording web browser activity, on the contrary, would involve determining which web pages were accessed and what data were entered into the web pages. Applicants' claimed saving a transaction, on the contrary, would involve, saving the accumulated recorded web browser activity over a period of time to memory or mass storage. Barrick's logging a time and Applicants' recording and saving a transaction are therefore different actions requiring different software to accomplish them.

V. CONCLUSION

Applicants assert that claims 1-20 are currently in condition for allowance for the following reasons, although not specifically limited thereto:

(1) Applicants' transaction is distinct from Barrick's recorded time and Barrick's protocol invocations such as an HTTP GET request, because web browser activity which forms Applicants' transaction is gathered from a series of web pages and their contents whereas recorded time could be the time between web pages but not the pages and contents themselves, and an HTTP GET request might request web pages but is not the page or the page's contents.

(2) Neither Applicants' claimed test instructions and nor Applicants' claimed transaction is equivalent to Barrick's HTTP GET request.

(3) Barrick's logging a time and Applicants' recording and saving a transaction are different actions requiring different software to accomplish them.

(4) Barrick does not disclose Applicants' claimed test instructions to record web browser activity to generate a transaction because Barrick does not track web browser activity but instead calculates the loading time for each web page.

(5) Barrick does not disclose or suggest Applicants' claimed test instructions to edit the transaction because editing a transaction could include, for example, changing the order of the web pages invoked, or changing the user data provided in the web page, while Barrick states providing timing information in an HTTP GET request.

(6) Barrick does not disclose Applicants' claimed recording browser activity as a series of steps, or recording browser activity at all, because recording browser activity as a series of steps involves recording the web pages that the user requests, the data entered into those web pages, and response to the requests, etc., while Barrick simply sends out specific defined web pages and computes a download interval. In Barrick, no browser activity is recorded whatsoever, in steps or otherwise.

(7) Barrick does not disclose Applicants' claimed editing a transaction, because Barrick is modifying a protocol packet to include data.

(8) There is no concept in Barrick whatsoever concerning required and prohibited strings.

Applicants respectfully assert that independent claims 1 and 11 are believed to be in condition for allowance and all dependent claims that depend upon allowable independent claims are therefore also believed to be in condition for allowance. In view thereof Applicants respectfully request the Examiner to find claims of this case allowable and to pass the application to issue.

Claims 10 and 20 have already been found to contain allowable subject matter, but have not been rewritten in independent form at this time because it is believed that all claims are allowable. Applicants reserve the right to rewrite claims 10 and 20 in independent form at later date if necessary.


Although no new fees are anticipated, the Commissioner for Patents is authorized to charge any further additional fees or credit overpayment to Deposit Account No. 50-1078.

The following information is presented in the event that a call may be deemed desirable by the Examiner:

JACOB N. ERLICH (617) 854-4000

Respectfully submitted,
Ellen M. Nelson et al., Applicants

Date: March 23, 2006

By: 
Jacob N. Erlich
Reg. No. 24,338
Attorney for Applicants